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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,480	02/13/2004	Keith L. Truog	51256/WGM/A23	5547
23363	7590	10/31/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER
			1774	
DATE MAILED: 10/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/779,480

Applicant(s)

TRUOG ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

ELECTION/RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to self-wound and multilayer decorative laminates, classified in class 428, subclass 195.1.
 - II. Claims 8-9, drawn to a process for making a multilayer decorative laminate, classified in class 156, subclass 230.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the article(s) of Group I can be made under thermal processing conditions and can be made utilizing injection molding or temperatures greater than 100 degrees F.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Walter Maxwell on October 21, 2005 a provisional election was made with traverse to prosecute the invention of I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-9 withdrawn from

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further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-4, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as previously presented.

It is not clear which color layer is referred to in the last paragraph of claims 1, 3-4, and 6 (i.e. through adhesive to the color layer, prevention of color change in the color layer) because there are two color layers referenced prior to this point. One color layer is a color layer on a substrate and painted, and the other is a color layer in the dry paint layer.

Secondly, it is not clear how a pressure-sensitive adhesive is adapted for adhering a laminate to a substrate nor a laminate being adapted for being self-wound into a roll, as the claims do not describe what this entails.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of U.S. Patent No. 6,649,003 to Spain et al. and claims 1-66 of U.S. Patent No. 5,725,712 to Spain et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are a process of making the same structural elements in the same order. Further, instant claims to capability of inhibiting or capturing pigments are given little patentable weight. That the barrier layer is able to capture or inhibit certain effects as claimed is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Because the same structural elements are provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner.

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That the PSA layer or overall laminate and its elements are adhered to a surface, or produced at a certain time and temperature and the release liner is peeled away from the dry paint layer are process limitations in a product claim and is given little patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,725,712 to Spain et al.

Spain teaches a multilayer decorative dry paint laminate in this order: pressure sensitive adhesive (PSA) (144, Fig. 14 and associated text), thin flexible backing barrier (142, Fig. 14 and associated text), dry paint color layer (46, Fig. 14 and associated text), clear color layer (45, Fig.

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14 and associated text), release liner (141 or 146, Fig. 14 and associated text, removable).

Because the same PSA is taught, it is adapted for adhering the laminate to a substrate surface at room temperature. Spain teaches the dry color layer contains binder and pigment (col. 14, lines 57-68). That the PSA layer or overall laminate and its elements are adhered to a surface, or produced at a certain time and temperature and the release liner is peeled away from the dry paint layer are process limitations in a product claim and is given little patentable weight.

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Spain teaches the clear color coat layer functions as a barrier in a sufficient film thickness to prevent color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat for application to a painted car also containing non-pigmented solids (col. 10, lines 30-40, col. 15, lines 30-col. 16, line 4). The barrier is made of PVDF-acrylic resin composition including a non-pigment and Elvacite (same as Applicant's acrylic resinous composition including a non-pigment as page 25, lines 1-6 describe) at col. 11, lines 45-68 and col. 15, lines 65-col. 16, line 20. Such description is equivalent to Applicant's language to a thin flexible barrier made of material that inhibits migration of discoloration-causing pigments including mono azo discoloration causing pigments from a painted substrate

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surface that sufficiently and essentially prevents color change in the color layer. Spain teaches color coats can also include metallic flake pigments and teaches the pigments dry on a substrate surface, thereby producing application of a color layer on a substrate surface (col. 37, lines 20-53). Thus, Spain was concerned with preventing defective color pigment transfer to painted surfaces (col. 20, lines 20-42, col. 37, lines 55-col. 38, line 4). That the barrier layer is able to capture or inhibit certain effects as claimed is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Because the same structural elements are provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner.

Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,649,003 to Spain et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Spain teaches a multilayer decorative dry paint laminate in this order: pressure sensitive adhesive (PSA) (144, Fig. 14 and associated text), thin flexible backing barrier (142, Fig. 14 and

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associated text), dry paint color layer (46, Fig. 14 and associated text), clear color layer (45, Fig. 14 and associated text), release liner (141 or 146, Fig. 14 and associated text, removable).

Because the same PSA is taught, it is adapted for adhering the laminate to a substrate surface at room temperature. See further col. 20, lines 20-42, col. 39, lines 1-25. Spain teaches the dry color layer contains binder and pigment (col. 14, lines 57-68). That the PSA layer or overall laminate and its elements are adhered to a surface, or produced at a certain time and temperature and the release liner is peeled away from the dry paint layer are process limitations in a product claim and is given little patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Spain teaches the clear color coat layer functions as a barrier in a sufficient film thickness to prevent color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat for application to a painted car also containing non-pigmented solids (col. 10, lines 30-40, col. 15, lines 30-col. 16, line 4). The barrier is made of PVDF-acrylic resin composition including a non-pigment and Elvacite (same as Applicant's acrylic resinous composition including a non-pigment as page 25, lines 1-6 describe) at col. 11, lines 45-68 and col. 15, lines 65-col. 16, line 20. Such description is equivalent to Applicant's language to a thin flexible barrier made of material that inhibits migration of discoloration-

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causing pigments including mono azo discoloration causing pigments from a painted substrate surface that sufficiently and essentially prevents color change in the color layer. Spain teaches color coats can also include metallic flake pigments and teaches the pigments dry on a substrate surface, thereby producing application of a color layer on a substrate surface (col. 37, lines 20-53). Thus, Spain was concerned with preventing defective color pigment transfer to painted surfaces (col. 20, lines 20-42, col. 37, lines 55-col. 38, line 4). That the barrier layer is able to capture or inhibit certain effects as claimed is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Because the same structural elements are provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 is rejected under 35 U.S.C. 103(a) as being obvious over USPN 5,725,712 to Spain et al. and USPN 6,649,003 to Spain et al. (both are applied below as “Spain” alternatively).

Spain teaches a multilayer decorative dry paint laminate in this order: pressure sensitive adhesive (PSA) (144, Fig. 14 and associated text), thin flexible backing barrier (142, Fig. 14 and associated text), dry paint color layer (46, Fig. 14 and associated text), clear color layer (45, Fig. 14 and associated text), release liner (141 or 146, Fig. 14 and associated text, removable). Because the same PSA is taught, it is adapted for adhering the laminate to a substrate surface at room temperature. See further col. 20, lines 20-42, col. 39, lines 1-25. Spain teaches the dry color layer contains binder and pigment (col. 14, lines 57-68). That the PSA layer or overall laminate and its elements are adhered to a surface, or produced at a certain time and temperature and the release liner is peeled away from the dry paint layer are process limitations in a product claim and is given little patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant’s and prior art reference’s product are the same.

Spain teaches the clear color coat layer functions as a barrier in a sufficient film thickness to prevent color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat for application to a painted car also containing non-

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pigmented solids (col. 10, lines 30-40, col. 15, lines 30-col. 16, line 4). The barrier is made of PVDF-acrylic resin composition including a non-pigment and Elvacite (same as Applicant's acrylic resinous composition including a non-pigment as page 25, lines 1-6 describe) at col. 11, lines 45-68 and col. 15, lines 65-col. 16, line 20. Such description is equivalent to Applicant's language to a thin flexible barrier made of material that inhibits migration of discoloration-causing pigments including mono azo discoloration causing pigments from a painted substrate surface that sufficiently and essentially prevents color change in the color layer. Spain teaches color coats can also include metallic flake pigments and teaches the pigments dry on a substrate surface, thereby producing application of a color layer on a substrate surface (col. 37, lines 20-53). Thus, Spain was concerned with preventing defective color pigment transfer to painted surfaces (col. 20, lines 20-42, col. 37, lines 55-col. 38, line 4). That the barrier layer is able to capture or inhibit certain effects as claimed is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Because the same structural elements are provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner.

While Spain teaches the dry film thickness is between 0.5 to 1.5 mils (col. 10, lines 30-40, col. 11, lines 10-20), Spain does not expressly state the thickness is not more than about 10% of the total thickness of the decorative laminate exclusive of the release liner. However, because Spain teaches the film thickness is varied to effect the appearance properties of the paint coat,

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variation of thickness is an optimizable feature. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being obvious over USPN 5,725,712 to Spain et al. and USPN 6,649,003 to Spain et al. (both are applied below as “Spain” alternatively) in view of USPN 5,506,031 to Spain et al. (“Spain ‘031”).

Spain teaches a multilayer decorative dry paint laminate in this order: pressure sensitive adhesive (PSA) (144, Fig. 14 and associated text), thin flexible backing barrier (142, Fig. 14 and associated text), dry paint color layer (46, Fig. 14 and associated text), clear color layer (45, Fig. 14 and associated text), release liner (141 or 146, Fig. 14 and associated text, removable).

Because the same PSA is taught, it is adapted for adhering the laminate to a substrate surface at room temperature. See further col. 20, lines 20-42, col. 39, lines 1-25. Spain teaches the dry color layer contains binder and pigment (col. 14, lines 57-68). That the PSA layer or overall laminate and its elements are adhered to a surface, or produced at a certain time and temperature and the release liner is peeled away from the dry paint layer are process limitations in a product claim and is given little patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113).

Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant’s and prior art reference’s product are the same.

Spain teaches the clear color coat layer functions as a barrier in a sufficient film thickness to prevent color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat for application to a painted car also containing non-pigmented solids (col. 10, lines 30-40, col. 15, lines 30-col. 16, line 4). The barrier is made of PVDF-acrylic resin composition including a non-pigment and Elvacite (same as Applicant's acrylic resinous composition including a non-pigment as page 25, lines 1-6 describe) at col. 11, lines 45-68 and col. 15, lines 65-col. 16, line 20. Such description is equivalent to Applicant's language to a thin flexible barrier made of material that inhibits migration of discoloration-causing pigments including mono azo discoloration causing pigments from a painted substrate surface that sufficiently and essentially prevents color change in the color layer. Spain teaches color coats can also include metallic flake pigments and teaches the pigments dry on a substrate surface, thereby producing application of a color layer on a substrate surface (col. 37, lines 20-53). Thus, Spain was concerned with preventing defective color pigment transfer to painted surfaces (col. 20, lines 20-42, col. 37, lines 55-col. 38, line 4). That the barrier layer is able to capture or inhibit certain effects as claimed is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Because the same structural elements are provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner (regarding instant claims 4-5).

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Spain does not expressly teach a fine particulate additive of a metal oxide dispersed in the acrylic resinous material in an amount to cause reduction of migration of pigments.

Spain '031 teaches a coat of acrylic resinous PVDF including a fine particulate additive such as aluminum silicate dispersed therein in order to produce color in dry paint finish laminates (col. 8, lines 1-10, and Examples 1 and 5).

It would have been obvious to one having ordinary skill in the art to have modified the multilayer film of Spain to have included a fine particulate additive of a metal oxide dispersed in the acrylic resinous material because Spain '031 teaches a coat of acrylic resinous PVDF including a fine particulate additive such as aluminum silicate dispersed therein in order to produce color in decorative dried paint print laminates (col. 7, line 65-col. 8, line 10, and Examples 1 and 5 of Spain '031). Further it is obvious to include the metal compounds in an amount to bring about the desired effect because the same materials are used and in combination would produce the claimed invention and functionality. Also the amount of metal used directly effects the opacity and color. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272.

Claim 6 is rejected under 35 U.S.C. 103(a) as being obvious over USPN 5,725,712 to Spain et al. and USPN 6,649,003 to Spain et al. (both are applied below as "Spain" alternatively) in view of USPN 5,506,031 to Spain et al. ("Spain '031") and further in view of USPN 5,084,317 to Epple.

Spain teaches a multilayer decorative dry paint laminate in this order: pressure sensitive adhesive (PSA) (144, Fig. 14 and associated text), thin flexible backing barrier (142, Fig. 14 and associated text), dry paint color layer (46, Fig. 14 and associated text), clear color layer (45, Fig.

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14 and associated text), release liner (141 or 146, Fig. 14 and associated text, removable).

Because the same PSA is taught, it is adapted for adhering the laminate to a substrate surface at room temperature. See further col. 20, lines 20-42, col. 39, lines 1-25. Spain teaches the dry color layer contains binder and pigment (col. 14, lines 57-68). That the PSA layer or overall laminate and its elements are adhered to a surface, or produced at a certain time and temperature and the release liner is peeled away from the dry paint layer are process limitations in a product claim and is given little patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Spain teaches the clear color coat layer functions as a barrier in a sufficient film thickness to prevent color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat for application to a painted car also containing non-pigmented solids (col. 10, lines 30-40, col. 15, lines 30-col. 16, line 4). The barrier is made of PVDF-acrylic resin composition including a non-pigment and Elvacite (same as Applicant's acrylic resinous composition including a non-pigment as page 25, lines 1-6 describe) at col. 11, lines 45-68 and col. 15, lines 65-col. 16, line 20. Such description is equivalent to Applicant's language to a thin flexible barrier made of material that inhibits migration of discoloration-causing pigments including mono azo discoloration causing pigments from a painted substrate

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surface that sufficiently and essentially prevents color change in the color layer. Spain teaches color coats can also include metallic flake pigments and teaches the pigments dry on a substrate surface, thereby producing application of a color layer on a substrate surface (col. 37, lines 20-53). Thus, Spain was concerned with preventing defective color pigment transfer to painted surfaces (col. 20, lines 20-42, col. 37, lines 55-col. 38, line 4). That the barrier layer is able to capture or inhibit certain effects as claimed is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Because the same structural elements are provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner (regarding instant claims 4-5).

While Spain teaches the dry paint layer comprising clear coat 45 is a transparent film on a carrier surface (col. 9, lines 19-22), Spain does not teach a matte release coat on the carrier.

Spain '031 teaches the lower surface of a carrier (26, Fig. 2 and 6 and associated text) is in contact with a matte release layer (24, Fig. 2 and 6 and associated text) to form a matte surface on the carrier sheet resulting in low surface gloss (col. 9, lines 55-68) and to freely release a carrier during a transfer process (col. 10, lines 1-5).

It would have been obvious to have modified the multilayer film of Spain to have included a matte release coat as claimed because Spain '031 teaches the lower surface of a carrier (26, Fig. 2 and 6 and associated text) is in contact with a matte release layer (24, Fig. 2 and 6 and associated text) to form a matte surface on the carrier sheet resulting in low surface

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gloss (col. 9, lines 55-68) and to freely release a carrier during a transfer process (col. 10, lines 1-5).

Spain does not teach winding or unrolling of a laminate as a self-wound laminate to perform as a rolled tape construction when releasing a surface as claimed.

Epple teaches an adhesive release of cured silicone adjacent adhesive (20 and 22, Fig. 2 and associated text) and adjacent to release liners (12 and 14, Fig. 2) self wound in a roll to release to adhere to automotive parts (col. 5, lines 1-66, Fig. 2 and 2a and Fig. 4-5).

It would have been obvious to one having ordinary skill in the art to have modified the combination to include winding or unrolling of a laminate as a self-wound laminate to perform as a rolled tape construction when releasing a surface as claimed because Epple teaches an adhesive release of cured silicone adjacent adhesive (20 and 22, Fig. 2 and associated text) and adjacent to release liners (12 and 14, Fig. 2) self wound in a roll to release to adhere to automotive parts (col. 5, lines 1-66, Fig. 2 and 2a and Fig. 4-5). The combination produces the instant claimed invention because the same construction and order is provided and would perform as claimed.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 6,703,089 to DeProspero et al. teaches a dry paint film: adhesive release/PSA

8. USPN 6,399,193 to Ellison teaches a dry paint film laminate having a pressure sensitive adhesive layer, clear coat layers of PVDF, and color coats applied as paint finishes.

9. USPN 4,598,020 to Panush teaches automotive paint compositions comprising color pigments and mono azo pigments for coating in automotive paint finishes.

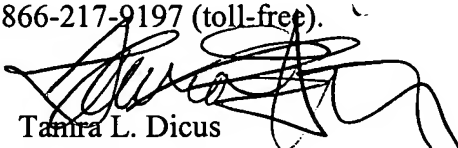
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10. USPN 6,875,800 to Vanier teaches automotive paint compositions comprising color pigments and mono azo pigments for coating in automotive paint finishes.
11. USPN 5,686,186 to Enlow teaches a wound laminate having release and matte release coatings.
12. USPN 6,613,411 to Kollaja teaches multilayer sheets for applying images and for use with vehicles having a release liner on any adhesive type layers including PSA or heat activated types having low surface energy for easy release.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tamra L. Dicus
Examiner
Art Unit 1774

October 23, 2005


RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. 1774 10/27/05